

Application No. 10/675,752

RCE and Reply to Office Action of January 10, 2006

### REMARKS / ARGUMENTS

The present application includes pending claims 1-30. Claims 1-28 have been previously rejected. Applicants have amended claims 1, 3, 4, 12, and 19 to further prosecution of the claims and to clarify the language used in these claims. Applicants have added new dependent claims 29 and 30, resulting from the current amendment of independent claim 1. Applicants do not believe that these amendments affect allowability of the claims.

Applicants request reconsideration of the claims in view of the amendments and the following remarks.

Claims 1-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,795,205 issued to Gacek (hereinafter, Gacek). Claims 19-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US 20020135808 issued to Parry (hereinafter, Parry). Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Gacek.

Applicants request reconsideration of the claims in view of the amendments and the following remarks.

#### **Claim Rejections under 35 U.S.C. § 102**

(Paragraphs 3 and 5 of the Office Action)

Claims 1-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gacek. Claims 19-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Parry.

With regard to the anticipation rejections under Gacek, MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2

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USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to the rejection of independent claim 1 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of "a first communication device deployed in a first residential location" and "a second communication device deployed in a second residential location," as claimed by Applicants in independent claim 1 as amended. The Office Action refers to items 102 and 103 in Figure 1 of Gacek as complying with the "at least one communication device" limitation disclosed by Applicants in claim 1 (Office Action, page 3). The Applicants respectfully traverse this assertion. More specifically, items 102 and 103 in Figure 1 of Gacek are "third-party merchants" and **not communication devices in a residential location** as claimed in the amended claim 1.

Furthermore with regard to the rejection of independent claim 1 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of "the first communication device deployed in the first residential location enables printing of the information content on the at least one personal printer resource, at a request of a user of the second communication device," as claimed by Applicants in independent claim 1. Gacek provides "a mechanism for an internet application to obtain authorization for the transmission of print data which is generated by the internet application over a cable network to a set-top box of a cable subscriber." Gacek at column 1, lines 20-25. In this regard, Gacek does not disclose or suggest the ability of a first user at a first location to print information content accessible by a second user at a second residential location, at the request of the second user, and vice versa.

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With regard to the rejection of independent claim 12 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of "a first communication device deployed at a first residential location" and "a second communication device deployed at a second residential location," as claimed by the Applicants in independent claim 12 as amended. The Office Action refers to item 102 in Figure 1 of Gacek as complying with this claim limitation of a first communication device disclosed by Applicants in claim 12. See the Office Action at page 7. The Applicants respectfully traverse this assertion. More specifically, item 102 in Figure 1 of Gacek is a "third-party merchant" and **not a communication device deployed at a first residential location**, as claimed in the amended claim 12.

Furthermore with regard to the rejection of independent claim 12 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of "the second communication device enables at least one of the following: pushing the information content to the first communication device and printing the information content on the personal printer resource," as claimed by the Applicants in independent claim 12. The Office Action refers to item 333 in Figure 3 of Gacek as complying with this claim limitation of a second communication device disclosed by Applicants in claim 12. See the Office Action at page 2. The Applicants respectfully traverse this assertion. More specifically, item 333 in Figure 3 of Gacek does not enable pushing the information content to the first communication device and printing the information content on the personal printer resource that is accessible by the first communication device, as claimed in amended claim 12.

With regard to the rejection of independent claim 19 under Parry, Applicants submit that Parry does not disclose or suggest at least the limitation of "searching through a plurality of video frames on a communication network via a first

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communication device at a first residential location, the first communication device being communicatively coupled to at least a second communication device at a second residential location via the communication network," as claimed by Applicants in independent claim 19. Figure 3 of Parry teaches that the printer receives video information and stores the video information in printer memory. Parry at page 2, paragraph [0023]. In addition, the searching is performed **only through the stored video information** (Parry, page 2, paragraph [0025]), and **not through "a plurality of video frames on a communication network,"** as claimed by Applicants in amended claim 19.

In addressing the Applicants' argument on claim 19, the Examiner's response states that "the first communication device would be any of the devices in either items 330 or 320 which are connected through the internet and the device 306 of the Fig. 3." See the Office Action at page 10. The Applicants would like to point out to the Examiner that there are no items 306, 320 or 330 in FIG. 3 of Parry. Apparently, the Office Action is erroneously referring to Fig. 3 of Gacek. Furthermore, it seems that the Office Action is equating searching through a plurality of video frames on the communication network and searching through video frames stored at the printer 118. See the Office Action at page 2. The Applicants respectfully disagree with this interpretation as it runs counter to what is disclosed and claimed by the Applicants' invention. Additionally, Parry does not teach or disclose "a first communication device at a first residential location, the first communication device being communicatively coupled to at least a second communication device at a second residential location," as claimed by Applicants in claim 19.

Based on at least the foregoing, Applicants believe the rejection of independent claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by Gacek has been overcome and request that the rejection be withdrawn. Based on

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at least the foregoing. Applicants also believe the rejection of independent claim 19 under 35 U.S.C. § 102(e) as being anticipated by Parry has been overcome and request that the rejection be withdrawn. Additionally, claims 2-11, 13-18, and 20-25 depend from independent claims 1, 12, 19, respectively, and are consequently also respectfully submitted to be allowable.

**Claim Rejections under 35 U.S.C. § 103**

(Paragraph 6 of the Office Action)

Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Gacek.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* Further, MPEP 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or



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suggest at least the limitation of "calling up printer resources available on the communication network using the communication device," as claimed by Applicants in independent claim 26. Figure 2 of Gacek discloses how a print job can be sent from an internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 and on to CPSI server 37 (Gacek, col. 7, lines 49-52). In this regard, Gacek does not disclose "calling up printer resources available on the communication network using the communication device," as claimed by Applicants in independent claim 26. The Office Action states that Gacek, column 7, lines 47-55 and specifically lines 52-55 discloses that printing resources of the home users are called up through the digital cable network. See the Office Action at page 3. The Applicants respectfully traverse this assertion. Gacek, column 7, lines 47-55 discloses the use of a "preference directory which stores information about the preferences and printing abilities of home users." The Applicants submit that Gacek does not disclose calling up printer resources, as claimed by the Applicants.

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of "selecting a printer resource from the available printer resources using the communication device," as claimed by Applicants in independent claim 26. The Office Action refers to Gacek, column 8, lines 13-18 for support with regard to this claim limitation. See the Office Action at page 3. Applicants respectfully traverse this assertion and submit that the referenced language in Gacek discloses the use of printer drivers to rasterize print jobs in a set-top box. In this regard, Gacek does not teach or disclose "selecting a printer resource from the available printer resources using the communication device," as claimed by Applicants in independent claim 26.

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With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of "viewing printing parameters of the selected printer resource using the communication device," as claimed by Applicants in independent claim 26. The Office Action refers to Gacek, column 8, lines 13-18 for support with regard to this claim limitation. Applicants respectfully traverse this assertion and submit that the referenced language in Gacek discloses a printer driver to rasterize a print job within set-top box 10 (Gacek, col. 8, lines 13-18). In this regard, Gacek does not teach or disclose "viewing printing parameters of the selected printer resource using the communication device," as claimed by Applicants in independent claim 26.

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of "accepting the printer resource and the printing parameters using the communication device," as claimed by Applicants in independent claim 26. The Office Action refers to Gacek, column 7, lines 50-55 for support with regard to this claim limitation. Applicants respectfully traverse this assertion and submit that the referenced language in Gacek discloses preference directory 21, which stores information about the preferences and printing abilities of home users (Gacek, col. 7, lines 50-55). In this regard, Gacek does not teach or disclose "accepting the printer resource and the printing parameters using the communication device," as claimed by Applicants in independent claim 26.

Additionally, the Examiner states in the Office Action at page 12 that Parry does not disclose "calling up printer resources available on the communication network using the communication device", "selecting a printer resource from the available printer resources using the communication device", "viewing printing parameters of the selected printer resource using the communication device", and

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"accepting the printer resource and the printing parameters using the communication device," as claimed by Applicants in claim 26. The Applicants respectfully agree.

Based on at least the foregoing, Applicants believe the rejection of independent claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Gacek has been overcome and request that the rejection be withdrawn. Additionally, Applicants believe the rejection of dependent claims 27-28 under 35 U.S.C. § 103(a) as being anticipated over Parry in view of Gacek has been overcome and request that the rejection be withdrawn.



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### CONCLUSION

Based on at least the foregoing, the Applicants believe that all claims 1-29 are in condition for allowance. If the Examiner disagrees, the Applicants respectfully request a telephone interview, and request that the Examiner telephone the undersigned Attorney for the Applicants at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

  
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Date: 13-FEB-06

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